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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,048	11/13/2003	Isabelle Rollat-Corvol	5725.0425-01	9222
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
SOROUSH, LAYLA				
ART UNIT		PAPER NUMBER		
1617				
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04/30/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/706,048

**Applicant(s)**

ROLLAT-CORVOL ET AL.

**Examiner**

LAYLA SOROUSH

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-44 is/are pending in the application.
- 4a) Of the above claim(s) 20-28 and 41-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-19 and 29-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The response filed February 4, 2008 presents remarks and arguments submitted to the office action mailed October 4, 2007 is acknowledged.

Applicant's arguments over the 35 U.S.C. 102 (b) rejection of claims 1,3-19,29-32 over Quack et al (US 4,150,216) is persuasive in part. Therefore, the rejection is herewith withdrawn.

Applicant's arguments over the 35 U.S.C. 103(a) rejection of claims 33-40 over Quack et al (US 4,150,216) is persuasive in part. Therefore, the rejection is herewith withdrawn.

Claims 33-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quack et al (US 4,150,216), as applied to claims 1,3-19,29-32 above, and further in view of Singleton et al. (US Pat No. 5,320,836 -- IDS) is persuasive in part. Therefore, the rejection is herewith withdrawn.

However, upon consideration of the arguments and newly amended claims the following new rejections are made:

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-19, and 29-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the specification for the recitation "wherein the conditioning agent is present in an amount ranging from 0.05 to 4% by weight relative to the total weight of the composition."

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-19, 29-32 rejected under 35 U.S.C. 103(a) as being obvious over Quack et al (US 4,150,216 -- IDS) in view of Bhatt et al. (US 5164177) .

Quack et al. teach hair-treatment compositions containing 0.1-10% branched water dispersible sulfo-group containing polyesters (abstract, col 18, lines 37-42). The polyesters of Quack et al. are made of the following radicals: dicarboxylic acids (e.g. succinic acid, azelaic acid), diols (e.g. ethylene glycol, propylene glycol), dicarboxylic acids carrying SO<sub>3</sub>M (e.g. sodium sulfosuccinic acid) and multifunctional reagents (e.g. glycerin, pentaerythritol, trimethylolpropane, trimethylethane). (col 9-16). The composition of Quack et al. may contain alcohol, water, silicone oils, waxes, fats as well as quaternary ammonium compounds (e.g. pentaerythritylstearyl ammonium chloride (col 18, lines 9-26; col 19 Example 3). The compositions of Quack et al. may be in the

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form of tonics, lotions, and sprayable formulation (col 18 lines 2-8). The compositions are applied to hair to set hair, to improve its texture and to shape it (col 1 lines 5-9).

Quack et al. fails to teach a non-volatile silicone in an amount of 0.05-4% by weight.

Bhatt et al. teaches a hair composition which includes from about 0.1% to about 10%, particularly about 0.5% to about 10%, and preferably from about 1.0% to about 5.0%, by weight of a non-volatile silicone compound or other conditioning agent(s), preferably a water-insoluble, emulsifiable conditioning agent. The preferred non-volatile silicone compound is a polydimethylsiloxane compound, such as a mixture, in about a 3:1 weight ratio, of a low molecular weight polydimethylsiloxane fluid and a higher molecular weight polydimethylsiloxane gum. The non-volatile polydimethylsiloxane compound is added to the composition of the present invention in an amount sufficient to provide improved combing and improved feel (softness) to the hair after shampooing.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the non-volatile silicone in the hair composition. The motivation is from the teachings of Bhatt et al. that the non-volatile silicone provides improved combing and improved feel (softness) to the hair after shampooing. Hence a skilled artisan would have reasonable expectation of successfully producing a composition with the same efficacy and results.

Claims 33-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quack et al (US 4,150,216) and Bhatt et al. (US 5164177), as applied to claims 1,3-19,29-32 above, and further in view of Singleton et al. (US Pat No. 5,320,836 -- IDS).

Quack et al. and Bhatt et al. are discussed above.

Although the reference teaches sprayable composition, the reference does not explicitly teach the claimed the claimed propellant.

Singleton teaches aerosol hair care compositions containing conventional propellants such as aliphatic hydrocarbons and dimethy ether (col 4 lines 34-66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use propellants taught by Singleton. The motivation to use the propellant is because Quack et al. teaches the use of sprayable hair compositions and Singleton teaches such sprayable compositions. Therefore, a skilled artisan would have reasonable expectation of successfully producing a sprayable composition with the propellant.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-19, and 29-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 14-24, 26-27, and 29 of U.S. Patent No. 6039933. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention herein is drawn to a cosmetic composition for treating keratin fibers comprising: at least one branched sulphonic polyester; and at least one conditioning agent chosen from non-volatile silicones, cationic and amphoteric polymers and cationic and amphiphilic surfactants whereas the prior art teaches a cosmetic composition according to claim 1, wherein said at least one fixing polymer is selected from anionic, cationic, amphoteric and non-ionic polymers.

It would have been obvious to a skilled artisan that the similar composition would be useful as a cosmetic for treatment of the hair because the prior art uses similar components as claimed.

Claims 1, 3-19, and 29-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-22 of U.S. Patent No. 6692730. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention herein is drawn to a cosmetic composition for treating keratin fibers comprising: at least one branched sulphonic polyester; and at least one conditioning agent chosen from non-volatile silicones, cationic and amphoteric polymers and cationic and amphiphilic surfactants whereas the prior art teaches a composition for washing keratinous materials, comprising, in a

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cosmetically acceptable aqueous medium, particles consisting essentially of aluminium oxide and having a mean primary size of less than 200 nm, at least one conditioning agent soluble or insoluble in the cosmetically acceptable aqueous medium, the conditioning agent being a cationic surfactant, a cationic polymer, a silicone, a vegetable oil, a ceramide, an anionic polymer, an amphoteric polymer or mixtures thereof, and at least one detergent surfactant, said composition not simultaneously containing an anionic surfactant and an amphoteric or nonionic surfactant.

It would have been obvious to a skilled artisan that a similar composition would be useful as a cosmetic for treatment of the hair because the prior art uses similar components as claimed.

Claims 1, 3-19, and 29-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-19 of copending application No. 10/320707. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention herein is drawn to a cosmetic composition for treating keratin fibers comprising: at least one branched sulphonic polyester; and at least one conditioning agent chosen from non-volatile silicones, cationic and amphoteric polymers and cationic and amphiphilic surfactants whereas the prior art teaches a Styling composition packaged in an aerosol device, comprising from 45% to 65% by weight of a liquid phase containing, in dissolved or finely dispersed form in a cosmetically acceptable aqueous or aqueous-alcoholic liquid medium, at least one branched sulphonic polyester, and from 35% to 55% by weight of

dimethyl ether as propellant, the total water content of the liquid phase being between 65% and 99% by weight.

It would have been obvious to a skilled artisan that a similar composition would be useful as a cosmetic for treatment of the hair because the prior art uses similar components as claimed.

Claims 1, 3-19, and 29-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of copending application No. 11/030296. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention herein is drawn to a cosmetic composition for treating keratin fibers comprising: at least one branched sulphonic polyester; and at least one conditioning agent chosen from non-volatile silicones, cationic and amphoteric polymers and cationic and amphiphilic surfactants whereas the prior art teaches a A composition for washing keratin materials, comprising, in a cosmetically acceptable aqueous medium, at least one polymer chosen from cationic and amphoteric polymers, at least one detergent surfactant chosen from anionic, nonionic and amphoteric detergent surfactants, and at least one drawing polymer with a drawing power of greater than 5 cm.

It would have been obvious to a skilled artisan that a similar composition would be useful as a cosmetic for treatment of the hair because the prior art uses similar components as claimed.

### **Declaration**

The 37 C.F.R. 1.132 Affidavits has been considered but is not persuasive. The reference of record teaches the use of branched sulphopolyesters as claimed.

### ***Response to Arguments***

Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Soroush whose telephone number is (571)272-5008. The examiner can normally be reached on 8:30a.m.-5:00p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/SREENI PADMANABHAN/**

**Supervisory Patent Examiner, Art Unit 1617**